



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/645,073	05/13/96	YOSHIOKA	M 1046.1133/JD

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PM52/0309

EXAMINER

GREGORY, B

ART UNIT

PAPER NUMBER

3642

DATE MAILED: 03/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/645,073

Applicant(s)

Makoto Yoshioka et al.

Examiner

Bernarr Earl Gregory

Group Art Unit

3642



☒ Responsive to communication(s) filed on Jan 23, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 7, and 9-14 is/are rejected.

☒ Claim(s) 6 and 8 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3642

1. This Office Action is in response to Applicants' Amendment A of January 23, 1998.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7, and 9-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Payne et al (U.S. Patent 5,715,314).

Claims 1-5, 7, and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al (U.S. Patent 5,023,907).

Payne et al (U.S. Patent 5,715,314) plainly shows the claimed subject matter as set forth in claims 1-5, 7, and 9-14. In Payne et al (U.S. Patent 5,715,314) please especially note column 4, line 35 through column 5, line 47. The feature described in Payne et al (U.S. Patent 5,715,314) as "a duration time that represents the length of time for which access to the product is to be granted to the user after completion of the purchase transaction" is especially significant. This quotation is found at column 5, lines 36-39.

Johnson et al (U.S. Patent 5,023,907) is similar to Payne et al (U.S. Patent 5,715,314). Please especially note in Johnson et al (U.S. Patent 5,023,907) that the Abstract states that the protected software may reside anywhere on the network. In addition, please especially note the

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Expiration of software licenses in Figure 2 of Johnson et al (U.S. Patent 5,023,907), which would be inherently enforced in Johnson et al (U.S. Patent 5,023,907).

4. Claims 6 and 8 are objected to as being dependent from rejected claims.

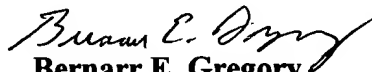
5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed "content" and "period" in claims 10 and 11 are non-functional descriptive material; therefore, they are not patentable subject matter under 35 USC 101. Please see section IV.B.1.(b) of the "Examination Guidelines for Computer-Related Inventions" (Final Version) as set forth by the Commissioner of Patents and Trademarks.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernarr Gregory whose telephone number is (703) 306-4153. **The Art Unit FAX number is (703) 306-4195. The Art Unit FAX machines are operated by clerical personnel, who may be reached at (703) 306-4177 (for receipt confirmation, etc.).**


Bernarr E. Gregory
Primary Examiner
Art Unit 3642

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March 4, 1998